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09/880,170	06/12/2001	Olga Milosavljevic	SCHB-4100	5814
20350 7590 02/25/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
OYEBISI, OJO O				
ART UNIT		PAPER NUMBER		
3696				
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02/25/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/880,170

**Applicant(s)**

MILOSAVLJEVIC ET AL.

**Examiner**

OJO O. OYEBISI

**Art Unit**

3696

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/25/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,5,7,9,11-20,36,39-41,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,9,11-20,36,39-41,43 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/25/08 has been entered. In the RCE filed on 08/19/08, the following have occurred: claims 3, 6, 21, 22, 34, 35, 37, 38, and 42 have been cancelled, new claim 44 has been added, claims 1, 4, 7, 11, 13, 40 and 43 have been amended, and claims 1-2, 4-5, 7, 9, 11-20, 36, 39-41 and 43-44 are currently pending.

### ***Claim Rejections - 35 USC §101***

1. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-2, 4-5, 7, 9, 11-20, 36, 39-41 and 43-44 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
3. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions (*In Re Bilski*), §101 process must (1) be tied to another statutory class

(such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

4. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.

5. In this particular case, regarding the first test, in performing the steps of the claimed subject matter recited in claims 1-2, 4-5, 7, 9, 11-20, 36, 39-41 and 43-44, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to another statutory class. Regarding the second test, since the claimed subject matter may be performed using only human intelligence, the steps do not sufficiently transform the underlying subject matter to be statutory. Thus, to qualify as a 101 statutory method, the claim should positively recite the other statutory class (the thing or product) to which it is tied and should sufficiently transform the underlying subject matter.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1-2, 4-5, 7, 9, 11-20, 36, 39-41 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corrin (US 2002/0035527 A1) in view of Longo (Tracey Longo. "The First Cut is the Cheapest: Retirement distributions can come from many sources, IRAs, 401(k)s, and so on. Knowing where to start can prolong earnings growth." Financial Planning. New York: Apr 1, 1999. p.g 1).

**Re Claim 1:** Corrin discloses a system for relating investment account information to an investment objective comprising:

- Inputting said income withdrawal goal (paragraph 0028), said estate goal (paragraph 0044), said years in retirement goal (0073, 0186)), and a current asset allocation (0029) and identifying one of said in-retirement goals as a priority goals as a priority goal (0010-0011, 0028-0030)
- Performing an analysis based on said in-retirement goals and said current asset allocation (paragraph 0010).
- Forecasting, by using the results of said analysis, said likelihood that said customer assets at retirement meet said priority goal (paragraph 0010, paragraphs 0129-0176)

- Providing a findings overview report based on said analysis, wherein the findings report includes the in-retirement goals, and the likelihood that the priority goal will be met if the in-retirement income stream withdrawal strategy is followed, and the findings overview report further including an asset drawn down schedule which shows predicted end of year balance for each of the plurality of customer accounts if the in- retirement strategy is followed (i.e., Corrin system provides investors with a complete account analysis and investment advisory report that quantifies meaningful saving goals, determines the effectiveness of the investor's current strategy, establishes investment performance expectations, offers investment guidance, and monitors and reevaluates their progress, see paras 0010-0011. Thus, Corrin's disclosure that his system provides investors with a complete account analysis and investment advisory report is akin to applicant's claimed limitation of providing a finding overview report based on the analysis. Further, the claim by the applicant that the finding report includes the in-retirement goals and asset drawn down schedule is met by Corrin's teaching of an advisory report that quantifies meaningful saving goals, determines the effectiveness of the investor's current strategy, establishes investment performance expectations, offers investment guidance, and monitors and reevaluates their progress, since meaningful saving goals, the effectiveness of the investor's current strategy, investment performance expectations, investment guidance encompass the in-retirement goals and asset drawn down schedule. Further still, the in-retirement goals and asset drawn down schedule are nothing but information/data which can easily be included in investment advisory report of Corrin without altering/changing the system of Corrin), projecting

annual snapshot cash flows from said current asset allocation and determining if a gap exists between projected cash flows and said income goal (paragraphs 0137-0138), providing a current performance planning table, wherein said table allows for assessing approximate current yield and total return information in order to determine which holdings of said assets provide cash flows versus growth required to meet said in-retirement goals (0084-0141 ), and further wherein said current performance planning table includes information on each asset's annual income, 1-year and 5-year total returns, and current value (note that Corrin discloses a performance planning table which includes various information, see pars 0084-0141. Corrin table shows value of the account balances, returns and the expected returns (see paras 0144). The examiner contends that 1-yr and 5-year total returns are nothing but expected returns, which are explicitly taught by Corrin (see paras 0144).

Corrin does not explicitly disclose the step of:

- Providing an in-retirement income stream withdrawal strategy, wherein said income stream strategy withdrawal provides tax advantages and wherein said income stream withdrawal provides for a first time period and said income stream withdrawal strategy avoids withdrawal of assets from tax deferred accounts during the first time period; and said income stream- withdrawal strategy providing for withdrawal from one or more tax deferred accounts during a second time period. However, Longo discloses a system for a retirement strategy for tax efficient withdrawals wherein assets are drawn first from taxable accounts followed, at a later time by withdrawing from tax deferred accounts (see abstract and entire article). Thus It would have been obvious to a person' of

ordinary skill in the art at the time of invention to include the teachings of Longo to the disclosure of Corrin so that a person in retirement can extend the life of their assets and achieve the most efficient withdrawal strategy possible.

**Re Claims 2:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses wherein said forecasting is based on outside (paragraph 0279-0282) and inside holdings (paragraph 0029 "current account balance.")

**Re Claim 4:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses wherein said cash flows comprise dividend and interest sources (0048) and non-fluctuating sources (0086-0093).

**Re Claim 5:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses wherein said dividend and interest sources comprise equity dividend, fixed income, and cash payments (0261 and 0280-0283)) and wherein said non-fluctuating sources comprise income property, social security, and pension payments (0086-0093)

**Re Claim 7:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses the step comprising generating a current summary showing a breakdown of said cash flows into said dividend and interest sources (0144-0150), said non-fluctuating sources (0097-0102), total cash flow and said income goal (0137-0138).

**Re Claim 9:** Corrin in view of Longo discloses the claimed method supra and while not explicitly disclosing the step wherein said withdrawal strategy further comprises



designating when and how much to withdraw from taxable, 401 K, traditional IRA and Roth IRA accounts, this step would have been obvious to anyone of ordinary skill in the art at the time of invention as it was notoriously well known. For example, there are tax related penalties related to the early withdrawal of funds from a Roth IRA account. If a user withdraws funds before the age of 59 ½ years there is a steep tax placed on the amount of withdrawal. Therefore, a prudent withdrawal strategy would be to refrain from withdrawing from this account until the appropriate time, and furthermore if it was vital for funds to be withdrawn, the strategy would further call for an amount representing the absolute minimum be withdrawn so that the remainder of the money in the account can continue to accumulate.

**Re Claim 11:** Corrin in view of Longo discloses the claimed method supra and while the references do not explicitly disclose the step comprising determining required minimum distribution income streams based on total value of tax deferred assets, this step would have been obvious to anyone of ordinary skill in the art, as such withdrawals were required by law. For example, in a traditional IRA, which is tax deferred, participants are required to make withdrawals at the age of 70 --½, so that the earnings can be taxed out. The minimum withdrawal is a rate based on life expectancy and therefore the amount of withdrawal would necessarily depend on the total value of the assets. Since these withdrawals are mandatory, it would therefore further be obvious to factor these into the withdrawal strategy, or else said strategy will ultimately become inaccurate.

**Re Claim 12:** Corrin in view of Longo discloses the claimed method supra and Corrin further discloses generating a report showing annual tax-deferred account withdrawals

and year-end tax deferred account balances (0216-0220).

**Re Claim 13:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses providing financial (0211; increase contribution) and non-financial (0228 "increase working years") alternatives in order to attempt to increase said likelihood of meeting retirement goals.

**Re Claims 14, 44:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses wherein said non-financial alternatives increase said likelihood by requiring a relaxing of at least one of said in-retirement goals (0028). In increasing the working years before retirement, the user is essentially decreasing the total number of years the user intends to spend in retirement.

**Re Claim 15:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses wherein said financial alternatives attempt to increase said likelihood by altering said asset allocation and thereby assuming a better diversified portfolio (0259-0261).

**Re Claim 16:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses generating a report showing said in- retirement goals and said likelihood versus said modified in-retirement goals, said modified in-retirement goals comprising said at least one of said relaxed in-retirement goals, and showing said subsequent possible increased likelihood (0263-0278).

**Re Claim 17:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses generating a report showing

said in- retirement goals and said likelihood versus said altered asset allocation, and sowing said subsequent possible increased likelihood (0213-0216 and 0263-0278)

**Re Claim 18:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses wherein asset allocation preferences are incorporated (0260-0262).

**Re Claim 19:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses providing action plans for attempting to increase said likelihood, said action plans comprising means for conveying whether to buy or sell said assets (0259-0262).

**Re Claim 20:** Corrin in view of Longo discloses the claimed method and Corrin discloses the claimed method supra and further discloses wherein each asset class holding are separated from each other and small company holdings are separated from large, international and fixed income company holdings (0261).

**Re Claim 36:** Corrin further discloses a performance planning report which identifies each of the assets held in the customer accounts and provides a projected annual cash flow (0046, 0048), an approximate current yield (0264), a historical total return (0029, 0037 'expected growth), and an approximated current value for each asset (0087), to assist the customer in assessing their assets on an income versus growth basis.

**Re claim 39.** Corrin further discloses the method further comprising acquiring an asset's current price through an existing, internal data feed updated nightly ((paragraph 0072-0073).

**Re claim 40.** Corrin further discloses the method, further comprising alerting a user when a cash flow analysis indicates a problematic fluctuation (see paras 0141)

**Re claim 41.** Corrin does not explicitly disclose the method, wherein the problematic fluctuation is indicated by a period wherein an actual monthly cash flow generated falls below a monthly cash flow goal by five percent or more. However, This limitation is only describing the problematic fluctuation which is a descriptive non-functional element which carries no patentable weight.

**Re claim 43.** Corrin further discloses the method, further comprising the step of calculating a percentage of dividends a customer is currently reinvesting versus accessing (see paras 0143)

### ***Response to Arguments***

Applicant's arguments filed 11/25/08 have been fully considered but they are not persuasive. The applicant argues in substance that the prior arts of record fails to disclose providing a current performance planning table, wherein said table allows for assessing approximate current yield and total return information in order to determine which holdings of said assets provide cash flows versus growth required to meet said in- retirement goals. Contrary to the applicant's assertion, Corrin discloses an expected return table, wherein the investor's expected long-term rates of return ranges of one-year returns for his current contribution and his existing account allocations are calculated respectively (see paras 0143-0144). Corrin further discloses that the expected return on each asset calculation uses the asset class numbers in the Asset

Allocation Data to choose the values from the Compound Return table that holds assumptions for long term rates of return for each asset class (see paras 0152). The limitation "wherein said table allows for assessing approximate current yield and total return information in order to determine which holdings of said assets provide cash flows versus growth required to meet said in- retirement goals, " is an intended use which carries no patentable weight.

The applicant further argues that the prior arts fail to disclose "wherein said current performance planning table includes information on each asset's annual income, 1-year and 5-year total returns, and current value." Contrary to the applicant's assertion, Corrin table shows value of the account balances, returns and the expected returns (see paras 0144). The examiner contends that 1-yr and 5-year total returns are nothing but expected returns, which are explicitly taught by Corrin (see paras 0144).

The applicant further argues that the prior arts fail to disclose providing a findings overview report based on said analysis, wherein the findings report includes the in-retirement goals, and the likelihood that the priority goal will be met if the in-retirement income stream withdrawal strategy is followed, and the findings overview report further including an assed drawn down schedule which shows predicted end of year balance for each of the plurality of customer accounts if the in- retirement strategy is followed. The examiner contends that Corrin system provides investors with a complete account analysis and investment advisory report that quantifies meaningful saving goals, determines the effectiveness of the investor's current strategy, establishes investment performance expectations, offers investment guidance, and monitors and reevaluates

their progress, see paras 0010-0011. Thus, Corrin's disclosure that his system provides investors with a complete account analysis and investment advisory report is akin to applicant's claimed limitation of providing a finding overview report based on the analysis. Further, the claim by the applicant that the finding report includes the in-retirement goals and asset drawn down schedule is met by Corrin's teaching of an advisory report that quantifies meaningful saving goals, determines the effectiveness of the investor's current strategy, establishes investment performance expectations, offers investment guidance, and monitors and reevaluates their progress, since meaningful saving goals, the effectiveness of the investor's current strategy, investment performance expectations, investment guidance encompass the in-retirement goals and asset drawn down schedule. Further still, the in-retirement goals and asset drawn down schedule are nothing but information/data which can easily be included in investment advisory report of Corrin without altering/changing the system of Corrin.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/  
Examiner, Art Unit 3696